

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
LWEP:122US

In Re Application Of: Katja Peter et al.



Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/773,952	February 6, 2004	Mark A. Robinson	24041	2872	7353

Invention: DEVICE AND METHOD FOR CONTROLLING FUNCTIONS OF A MICROSCOPE SYSTEM

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

December 20, 2006

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Dated: February 7, 2007

Michael L. Dunn
 Reg. No. 25330
 Simpson & Simpson, PLLC
 5555 Main Street
 Williamsville, New York 14221
 (716) 626-1564 Phone
 (716) 626-0366 Fax

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Michael L. Dunn

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Attorney Docket No. L WEP:122US
U.S. Patent Application No.10/773,952
Date: February 7,2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Katja Peter et al.

U.S. Patent Application No. 10/773,952

For: DEVICE AND METHOD FOR
CONTROLLING FUNCTIONS OF A
MICROSCOPE

Filed: February 6, 2004

Examiner: Robinson, Mark A.

Group Art Unit: 2872

Confirmation No.: 7353

Customer No.: 24041

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Michael L. Dunn
Reg. No. 25330

APPEAL BRIEF (37 CFR 41.37)

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Honorable Sir:

Applicants respectfully appeal the decision of the Examiner finally rejecting Claims 1, 3 and 31 as set forth in the Office Action dated August 2, 2006 and Advisory Action of December 4, 2006 . A Notice of Appeal was timely filed by the Applicants on December 20, 2006.

Real Parties in Interest

The real party in interest is LEICA MICROSYSTEMS WETZLAR GMBH, Assignee of the above application by assignment recorded in the Patent and Trademark Office at Reel 014387, Frame 0958

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

The application originally contained 30 claims. Claim 31 has been added by amendment. No claims have been cancelled. Claims 1-3, 23-29, and 31 have been amended. Claims 2 and 14-30 have been allowed. Claims 1, 3 and 31 are rejected and claims 4-13 have been withdrawn from consideration. Claims 1, 3 and 31 are involved in the appeal.

Status of Amendments

No amendments have been offered that have not been entered.

Summary of the Invention

A device for controlling functions of a microscope within a microscope system. The device includes a stand base portion, a central display integrated into the stand base portion, wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system, to call saved settings of the microscope within the microscope system and to receive warning messages or notifications from the microscope within the microscope system. The invention also includes the above device wherein a main menu is constructed from multiple sub-main menus; and depending on the selection of the sub-main

menu by the user, a respective submenu corresponding to the selected sub-main menu is displayable on the display and the above device where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection.

Issues Presented for Review

1. Whether claim 1 is patentable under 35 U.S.C. 102 as being anticipated by U.S. Patent 6,235,014 to Abe et al; and
2. Whether claims 3 and 31 are patentable under 35 U.S.C. 103 as being obvious to one skilled in the art over Abe (et al) above.

Grouping of Claims

The claims do not stand or fall together. Claim 3 includes the further limitation over claim 1 wherein a main menu is constructed from multiple sub-main menus; and depending on the selection of the sub-main menu by the user, a respective submenu corresponding to the selected sub-main menu is displayable on the display. This further limitation lends patentability over and above the patentable limitations already in claim 1. Claim 31 includes the limitation where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection. This further limitation lends patentability over and above the patentable limitations already in claim 1.

Argument

Claim 1 has been rejected under 35 U.S.C. 102 as being anticipated by U.S. Patent 6,235,014 to Abe et al. This rejection is improper and should be reversed.

Claim 1 requires "A device for controlling functions of a microscope within a microscope system, said device comprising: a stand base portion, a central display integrated into the stand base portion, wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system, to call saved settings of the microscope within the microscope system and to receive warning messages or notifications from the microscope within the microscope system."

In applying Abe et al., the Examiner states: "Abe discloses a device for controlling microscope functions including a display (3) integrated into a stand base portion, wherein the display can be used to perform settings of the microscope, call saved settings, and display warnings or notifications from the system (see also figs. 1-3).

This statement by the Examiner with respect to the disclosure of Abe et al. is incorrect and even if it were correct is insufficient to support a rejection under either 35 U.S.C. 102 or 103.

Present claim 1 requires: A device for controlling functions of a microscope within a microscope system..." It is clear that the claim requires **control of microscope functions** as microscope functions would be understood by one skilled in the art. A "microscope" as defined in McGraw Hill's Dictionary of Scientific and Technical Terms, 2nd edition, (1978) at page 1023 as "An instrument through which minute objects are enlarged by means of a lens or lens system". The definition has not significantly changed since 1978. Reference may presently be had on-line to <http://en.wikipedia.org/wiki/Microscope>. "A microscope ... is an instrument for viewing objects that are too small to be seen by the naked or unaided eye." (word origin information omitted).

It is therefore clear to any person of ordinary skill in the art that “functions of a microscope” or “settings of the microscope”, as in claim 1, must be for a microscope, not for some unrelated or ancillary apparatus or function, e.g. changing intensity or direction of a laser is not a function of a microscope unless it relates to seeing minute objects.

Abe et al. does not disclose or suggest anything at all concerning control of any function of a microscope using a display and in making such an assertion, the Examiner is over extending the reference based upon hindsight application of the present invention beyond any reasonable disclosure or suggestion actually within the Abe et al. reference.

Contrary to the position of the Examiner, Abe et al. **does not** disclose or suggest a device for controlling microscope functions; **does not** disclose or suggest a display (3) integrated into a stand base portion; and **does not** disclose or suggest a display that can be used to perform settings of the microscope, call saved settings, and display warnings or notifications from the system (see also figs. 1-3). **It is irrelevant that other functions can also be controlled by the display in accordance with the presently claimed invention because the cited art does not disclose or suggest control of microscope functions whether or not additional functions can be controlled with the display.** Abe et al is in fact irrelevant to the present invention.

Abe et al does not disclose or suggest any such limitations or requirements.

Abe et al does not disclose or suggest a central display **integrated into the stand base portion.** The display of Abe et al. has a display (control panel 3) integrated into a laser oscillator 1 **not into a stand base portion as has always been required by claim 1.** For this reason alone the rejection under 35 U.S.C. 102 must be withdrawn since each and every limitation of the

claim must be disclosed in the reference for such an anticipation rejection under 35 U.S.C. 102 to be proper. Further, there is no suggestion at all of incorporating a central display into a stand base portion of a microscope system. In addition there is no disclosure or suggestion of “a central display is used to perform a plurality of settings of the microscope within the microscope system” as presented in claim 1 as amended.

The control panel of Abe et al does not appear to be directed to controlling any functions of a microscope and certainly not a plurality of such microscope functions. Rather, the control panel of Abe et al is directed to controlling laser treatment energy for laser eye surgery and there appears to be no suggestion of any control of microscope function. The control panel of Abe et al. can in no way be used to control “a plurality” of the functions of a microscope and no such display having such ability is remotely suggested.

The present claims require that the “...display can be used to perform a plurality of settings of the microscope within the microscope system.” **It is irrelevant that other functions can also be controlled by the display in accordance with the invention because the cited art does not disclose or suggest control of microscope functions whether or not additional functions can be controlled with the display.**

The Examiner has rejected claims 3 and 31 under 35 U.S.C. 103 as being unpatentable over Abe (et al) above. This rejection should be reversed.

With respect to claim 3, after the Examiner admits that: “Abe does not disclose the display to display main, sub-main, and submenus”, the **Examiner simply states, without citation of any supporting reference, that:**

“This type of ‘nested’ menu structure is very well known and commonly used in display systems. It would have been obvious to use such a menu structure including these types of menus in Abe’s system in order to organize the information and control systems, thus making them easy to use.”

There is no discussion at all by the Examiner of their unique use in conjunction with microscopic functions and no cited support for use with microscopic functions or even for their use with anything. The use of such a system to control microscopic functions is unique and unobvious to one skilled in the art, especially within a display in a microscope stand.

With respect to claim 31, the rejection is even more clearly improper.

Claim 31, depending from claim 1, requires that the plurality of settings that can be performed include at least one of objective selection and secondary magnification. There is absolutely no suggestion in Abe et al of any display or control capable of performing either of such settings and certainly not in conjunction with other microscopic functions.

The Examiner admits:

“Regarding claim 31, Abe does not specifically teach the display to control either objective selection or magnification selection.”

The Examiner then simply states without any reference in support,

“However, Abe discloses both of these functions in relation to a microscope. It would have been obvious to the ordinary skilled artisan at the time of the invention to use Abe’s display/control to control either or both of these functions in order to provide the user with convenient location of all of the controls of the system, thus making the system more efficient and compact.”

This is impermissible hindsight at its most egregious. Abe et al does not disclose or suggest the use of a display to control microscope functions at all, yet the Examiner takes the unsupported hindsight position that it would be obvious to take manual controls from a

microscope associated with the Abe et al. structure and incorporate them into a display that Abe et al only uses for treatment lasers. **If the advantages are so clear, as the Examiner would have us believe, why did Abe et al. not actually incorporate microscopic controls into the display.** The answer is clear, prior to the present invention, it was not obvious to one skilled in the art from Abe et al., to incorporate microscope controls into a display and certainly not within a microscope stand.

The rejections should be reversed and claims 1, 3 and 31 should be allowed.

Conclusion

In view of the foregoing, it is clear that the pending claims are patentable over the cited prior art. Reversal of the Examiner and allowance of all claims are therefore respectfully requested.

Respectfully submitted,



Michael L. Dunn
Registration No.25,330
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

MLD/mjk
Dated: February 7, 2007

Appendix

Reprinted below are the claims involved in the appeal:

1. A device for controlling functions of a microscope within a microscope system, said device comprising: a stand base portion, a central display integrated into the stand base portion, wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system, to call saved settings of the microscope within the microscope system and to receive warning messages or notifications from the microscope within the microscope system.
3. The device as defined in Claim 1, wherein a main menu is constructed from multiple sub-main menus; and depending on the selection of the sub-main menu by the user, a respective submenu corresponding to the selected sub-main menu is displayable on the display.
31. The device of claim 1 where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection.